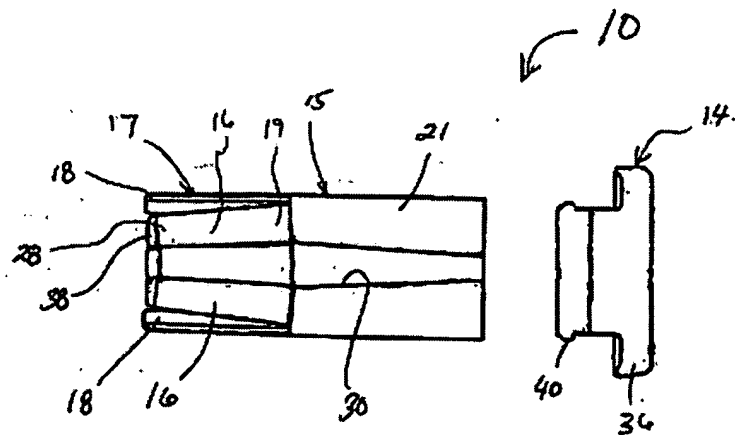


REMARKS

Claims 1-4 are currently pending in the application. Claims 1-3 are amended. The amendments find support in the specification. For instance, that the centering sleeve includes radially expandable elements is supported throughout specification, such as at page 3, lines 12-15. Placement of the second component onto a distal end of an endoscope is supported throughout specification, *e.g.*, at page 3, lines 25-26. No new matter is added.

APPLICANTS' INVENTION

Applicants' invention is a mounting adaptor for an endoscope accessory, which allows an endoscope accessory to be joined to a range of differently-sized endoscopes from different manufacturers. It provides a frictional fit that secures the accessory to the endoscope. The adaptor 10 includes a radially flexible centering sleeve 15 and a collar 14. The centering sleeve 15 fits within the bore 20 of the endoscope accessory 12, and is pushed to the distal end of the accessory bore. The centering sleeve 15 includes resiliently radially expandable elements that will engage the endoscope shaft surface and will also absorb variances in clearance between the endoscope shaft diameter and the inside diameter of the accessory.



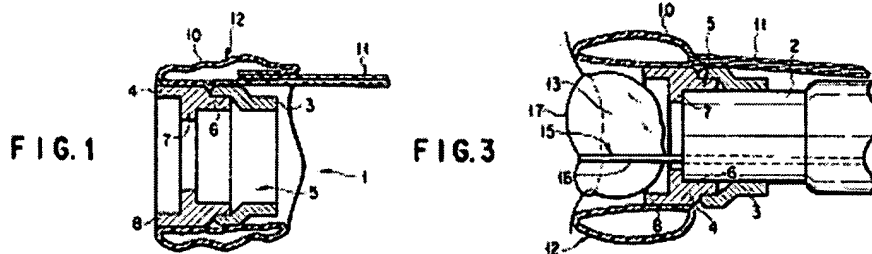
In use, the centering sleeve 15 is inserted through the proximal end of the bore of the accessory, with the resilient elements pointing distally. The collar 14 is then pushed into the proximal end of the accessory bore 20. The distal end of the endoscope is then inserted into the proximal end of the accessory 12, through the collar 14 and the centering sleeve 15, so that the adapter

frictionally engages both the outside surface of the endoscope shaft and the inside surface of the accessory.

THE CITED ART

U.S. Pat. No. 6,306,081 to Ishikawa *et al.* ("Ishikawa")

Ishikawa discloses a hood 8 for an endoscope, which is detachably mounted near a distal end of the endoscope, and includes an annular balloon 10. The balloon 10, when inflated (see, *e.g.*, Fig. 3), expands into a "hood-like configuration" (Fig. 2), thus serving as an extension of the hood (column 3, lines 55-60). The stated advantage of the balloon/hood is that it provides a greater observation area (column 3, line 65 - column 4, line 5), and in situations where the observation area is obscured by the balloon/hood itself, the balloon can be deflated/retracted (column 4, lines 6-15) (see, *e.g.*, Fig. 1).



The hood itself 8 has a mount member 3 that is mounted over an outer peripheral portion of a distal end section of an insertion section of an endoscope. The mount member is "intimately joined, adhesively bonded or threaded" (col. 2, lines 50-53) to the outer surface of the endoscope. A joining member 4 is bonded to the front end of mount member 3. The mount member 3 and joining member 4 are integrally connected to provide a "basic body."

Claim Rejections

The claims were rejected under 35 U.S.C. § 103 as obvious in view of Ishikawa. The office action views Ishikawa's mount member 3 as constituting applicants' collar 14, and Ishikawa's joining member 4 as constituting applicants' centering sleeve.

The office action also takes the position that, while Ishikawa is silent as to the material from which the mount member and joining member are made, "it is inherent that they must exhibit some flexibility so that they can be positioned properly over the endoscope and maintain a frictional fit".

Applicants traverse this interpretation. Furthermore, the claims as currently amended state that the centering sleeve includes radially expandable elements. Ishikawa neither discloses nor suggests such elements, and the rejection on this basis must therefore be reconsidered and withdrawn.

Furthermore, applicants respectfully submit that it is not inherent that Ishikawa's mount member and joining member must have some flexibility. The MPEP discusses inherency at § 2112, and states that:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) . . . ; *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

(MPEP § 2112(IV), emphasis added).

Thus, the mere possibility that the joining member 4 and the mount member 3 of the Ishikawa device are flexible is insufficient to support a rejection based on inherency. One of ordinary skill, reading Ishikawa, must see that these pieces are *necessarily* flexible.

However, this reference does not support such an interpretation. Ishikawa states (at col. 2, lines 50-56) that:

The mount member 3 is intimately joined, adhesively bonded or threaded, for example, to the outer peripheral surface of the distal end portion 2 of the endoscope. A joining member 4 is, for

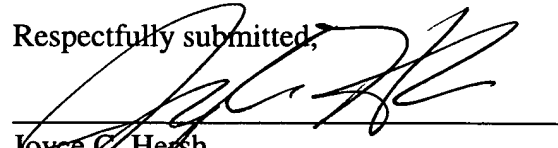
example, bonded to the front end of the mount member 3. The mount member 3 and joining member 4 are integrally connected to provide a basic body (body member) 5.

There is no teaching or suggestion that these parts are, need to be, or should be, flexible, nor is there any statement that might lead one to believe that flexibility might be useful or desirable, such as a statement that the mount member and joining member could be used with endoscopes and accessories of different sizes.

There is therefore nothing in Ishikawa to lead one to believe that the mount member and joining member are necessarily flexible, and the rejection on the basis of this reference should therefore be reconsidered and withdrawn.

Applicants submit that all of the claims are now in condition for allowance, which action is requested. Please apply any charges or credits to Deposit Account No. 50-1721.

Respectfully submitted,



Joyce C. Herish
Reg. No. 42,890
Attorney for Applicant
KIRKPATRICK & LOCKHART
NICHOLSON GRAHAM LLP
75 State Street
Boston, MA 02109-1808
Tel: 617-261-3100
Fax: 617-261-3175

Date:

March 3, 2005